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David George De Vorchik

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SHOOK, HARDY & BACON L.L.P.  
(MICROSOFT CORPORATION)  
INTELLECTUAL PROPERTY DEPARTMENT  
2555 GRAND BOULEVARD  
KANSAS CITY, MO 64108-2613

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DAVID GEORGE DE VORCHIK and DAVID JOEL SHELDON

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Appeal 2009-004529  
Application 10/015,958  
Technology Center 2100

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Decided: May 27, 2010

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Before JAMES D. THOMAS, LEE E. BARRETT, and ST. JOHN  
COURTENAY III, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

Dissenting-in-part opinion by BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 3, 7 through 11, 14, 16, 18, and 19. We have jurisdiction under 35 U.S.C. § 6(b).

We vacate all the rejections before us under 35 U.S.C. § 102 and 35 U.S.C. § 103 and institute a new ground of rejection within the provisions of 37 C.F.R. § 41.50(b).

## INVENTION

The present invention provides a system and method that allows software developers to more effectively chain and extend wizards. Using this method, a software developer will indicate within the software code, access points or those stages in the process where an external wizard or HTML pages could be incorporated. Furthermore, a developer can also create reusable parts of a wizard (sub-wizard) that can be incorporated into other wizards (host-wizard), thus allowing the extension of the host-wizard. Sub-wizards can be component objects and/or contain HTML pages from the Internet or other sources. A host-wizard and one or more sub-wizards can exchange information and pass control through the specification of certain object functions and a 'property bag'. A 'property bag' can be thought of as an assorted collection of miscellaneous data, variables and other information that a developer needs to exchange between wizards.

(Spec. 24, Figures 2 through 4.)

## REPRESENTATIVE CLAIM

1. A method for use in a computing environment for extending a wizard comprising:

generating a host-wizard component;

generating one or more sub-wizard components;



environment and in a predictable manner. This alleviates problems that are encountered by a user that is unfamiliar with the program environment. A wizard also facilitates the accomplishment of certain critical or mundane and repetitive tasks. Another wizard definition is a multi-step process that is controlled by a user's navigation of screens in order to answer questions and ultimately complete an operation. Screen navigation is typically accomplished using next and back buttons. A wizard is constructed from a series of dialog boxes, templates, text, and programmed code that respond to user selections. The dialog boxes are passed to procedure frameworks, which display the wizard pages in the order that they were created, or in an order that is defined by the backing programmed code. Certain portions or the entire functions of a particular wizard can be utilized with multiple software applications or with various system configuration needs because of a wizard's broad base applicability to the computing environment.

Lastly, Specification page 6, lines 6 through 15, state:

Figure 1 illustrates an example of a suitable computing system environment 100 in which the invention may be implemented. The computing system environment 100 is only one example of a suitable computing environment and is not intended to suggest any limitation as to the scope of use or functionality of the invention. Neither should the computing environment 100 be interpreted as having any dependency or requirement relating to any one or combination of components illustrated in the exemplary operating environment 100.

The invention may be described in the general context of computer-executable instructions, such as program modules, being executed by a computer. Generally, program modules include routines, programs, objects, components, data structures, etc. that perform particular tasks or implement particular abstract data types.

## ANALYSIS

We vacate the three prior art rejections encompassing all claims on appeal because we conclude that all claims on appeal, claims 1 through 3, 7

through 11, 14, 16, 18, and 19 are “barred at the threshold by § 101.” *In re Comiskey*, 554 F.3d 967, 973 (Fed. Cir. 2009) (citing *Diamond v. Diehr*, 450 U.S. 175, 188 (1981)). Therefore, the following new ground of rejection is set forth in this Opinion within the provisions of 37 C.F.R. § 41.50(b).

## NEW REJECTION UNDER 35 U.S.C. § 101

### PRINCIPLES OF LAW

#### *Statutory Subject Matter*

The subject matter of claims permitted within 35 U.S.C. § 101 must be a machine, a manufacture, a process, or a composition of matter. Moreover, our reviewing court has stated that “[t]he four categories [of § 101] together describe the exclusive reach of patentable subject matter. If the claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007), *reh’g en banc denied*, 515 F.3d 1361 (Fed. Cir. 2008), *cert. denied*, 127 S. Ct. 70 (2008). *Accord In re Ferguson*, 558 F.3d 1359 (Fed. Cir. 2009). This latter case held that claims directed to a “paradigm” are nonstatutory under 35 U.S.C. § 101 as representing an abstract idea. Thus, a “signal” cannot be patentable subject matter because it is not within any of the four categories. *In re Nuijten*, 500 F.3d at 1357. Laws of nature, abstract ideas, and natural phenomena are excluded from patent protection. *Diamond v. Diehr*, 450 U.S. at 185. A claim that recites no more than software, logic or a data structure (i.e., an abstraction) does not fall within any statutory category. *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994). Significantly, “Abstract software code is an idea without

physical embodiment." *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 449 (2007).

## ANALYSIS

With this background in mind, claims 1 through 3, 7 through 11, 14, 16, 18, and 19 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Consistent with our earlier-noted invention statement from Appellants' disclosed Abstract and in view of our Brief findings of fact section in this opinion, the disclosed and claimed invention is directed to software per se, abstract ideas, abstract concepts and the like, including software components/interfaces, software modules, wizard application programs per se and data structures, such as information containers and property bags. All claims on appeal merely recite an intended use environment by the use of the terms "for use in a computing environment." In comparison to the computing environment 100 disclosed Figure 1, the description of this Figure from our reference to it in our findings of fact is that it is to be considered essentially as undefined or open ended and not limiting.

Independent claims 9, 11, and 14 are directed to nominal recitations of structure only in the preamble. The system in independent claim 9 is merely stated to be potentially "operable to execute a method for use in a computing environment for extending a wizard comprising." This claim is directed in the body of it to the same method as the subject matter in representative independent method claim 1. The subject matter of independent claims 11 and 14 directly recite in the body of them the software entities noted earlier.

In all of claims 9, 11, and 14, no structural element of the preamble is recited in the body of these claims. As indicated earlier, the structural elements illustrated in disclosed Figure 1 are not to be imputed to these system claims. In effect, these claims recite software systems.

Specific mention is now made of the machine-readable medium claims 8 and 10. According to Specification page 7, lines 5 through 7, computer readable media include communication media. Thus, these claims are inclusive of signal embodiments, which are proscribed by the earlier-noted case law. As such, the media of these claims include transitory embodiments, such as to comprise signals per se. Note also the analysis provided by *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010).

## CONCLUSION AND DECISION

We have *pro forma* reversed the three outstanding rejections over applied prior art that encompass all claims on appeal, claims 1 through 3, 7 through 11, 14, 16, 18, and 19. We have instituted a new ground of rejection within 37 C.F.R. § 41.50(b). This new rejection of all claims on appeal is based upon 35 U.S.C. § 101 since these claims are directed to non-statutory subject matter.

A new ground of rejection is pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of



rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b)) as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ....

(2) *Request rehearing*. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ....

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

VACATED  
37 C.F.R. § 41.50(b)

BARRETT, *Administrative Patent Judge*, dissenting-in-part.

I agree with the new ground of rejection under 35 U.S.C. § 101 of claims 8, 10, and 18, but respectfully dissent from the new ground of rejection for claims 1-3, 7, 9, 11, 14, 16, and 19. In my opinion, claims 1-3, 7, 9, 11, 14, 16, and 19 should be examined on the prior art.

I agree that claims 8, 10, and 18 to a "machine readable medium having machine executable instructions for performing a method" are properly rejected under § 101. "Machine readable instructions" *per se* are not within any of the four statutory categories of 35 U.S.C. § 101 and therefore are not patent eligible subject matter. The claimed "machine readable medium" is not limited to a tangible physical medium (a "manufacture" under § 101) either explicitly (e.g., "a disk containing machine readable instructions") or implicitly (e.g., "machine readable instructions stored on a machine readable medium" where "stored" implies structure because signals "transmitted" on a carrier wave are not stored). Claims that are so broad that they read on nonstatutory as well as statutory subject matter are unpatentable. *See Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010). *Cf. In re Lintner*, 458 F.2d 1013, 1015 (CCPA 1972) ("Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter.").

I disagree with the rejection of method claims 1-3, 7, and 16. These claims fall within the category of a "process" under § 101 absent an analysis of why they are not.

I also disagree that claims 9, 11, 14, and 19 to a "computer system" are not patent eligible. A "computer system" is an apparatus, which is a

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"manufacture" under § 101. The fact that the structure is recited in the preamble does not make the claim any less of a manufacture in my opinion.

rwk

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(MICROSOFT CORPORATION)  
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KANSAS CITY, MO 64108-2613